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10/729,162	12/05/2003	Eric Walker	03-026	8570

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VISTA PRINT USA INC.  
ATTN: PATENT COUNSEL  
100 HAYDEN AVENUE  
LEXINGTON, MA 02421

EXAMINER

FABER, DAVID

ART UNIT PAPER NUMBER

2178

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/729,162

Applicant(s)

WALKER, ERIC

Examiner

David Faber

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to the application filed on 5 December 2003.

**This action is made Non-Final.**

2. Claims 1-17 are pending. Claims 1,6, 10, 13, and 16 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 28 March 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Document 1 under Non Patent Literature Documents fails to disclose the date list within the IDS. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 150, and 332. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

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application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 130, and 318. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 6-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2105 :

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se  
**Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory** because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

**Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.**  
**When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.**

8. Claims 6-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program per se. Since the computer program is not embodied on a tangible computer readable medium, they appear non-statutory.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-4, 6-8, 10-11, 13-14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Coloring.com (Coloring.com, "Coloring.com - free online interactive coloring pages and coloring books", pp 1-25)

Examiner provides printouts (pgs 1-16) that Coloring.com of showing the features and functionality disclosed to as early as November 29, 2002. Furthermore, Examiner used Screenshots taken on 8/1/2006 to show the complete and working functionality of the features within Coloring.com that has been accessible since at least November 29, 2002.

As per independent claim 1, Coloring.com discloses a method comprising:

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- associating at least one color with a markup language element capable of accepting content, (pp 8, 9-16,17-18: Discloses a web site being viewed in a web browser with markup elements being shown capable of receiving colors from the palette on the left menu of colors. PP 9-16, 18 and discloses the source code behind the web page of the element showing Javascript elements used to display a graphic or image that contain many patterns and shapes used to form a figure on a different colored background. The Javascript code written in HTML enables the graphic or image to accept colors. In addition, a user can choose among the colors on the palette to the left .(pp 8, 17) )
- applying a grayscale image as content of the element, and (Coloring.com discloses a grayscale images wherein only the two colors are shown, white and black; wherein black and white images are a form of grayscale images. Thus, the grayscale image is used as content for the element shown in pp 8, 17 of the web page.
- modifying the content image by applying the at least one color associated with the element as at least one color component of the content image. (A user selects a color on the color palette on the menu on the left. Then once the color has been selected, the user clicks on a pattern of a portion of the image to fill it with the selected color. Doing so fills the up that portion or pattern with that color shown in pp 20-22.)

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As per dependent claim 3, Coloring.com discloses a method further:

- displaying at least the modified content image to a user of the computer browser program (pp 22)
- providing a color palette containing a plurality of individually selectable colors, (pp 22 shows a palette full of a plurality of individual selectable colors on the left side)
- allowing the user to select a color from the palette, (pp 20, 23: user able to select a color)
- after the selection of a color by the user, modifying the content image by replacing one of the color components of the content image with the selected color, and displaying the newly modified content image to the user. (pp 23-25: user selects a color, clicks on the already modified portion of the content of colored filled in from pp 22, wherein pp 25 discloses the new color replacing the old color.)

As per dependent claim 4, Coloring.com discloses a method wherein the element is a shape and the grayscale is applied as pattern fill content of the shape. (eg. Pp17 discloses an image as a form of grayscale that contains multiple shapes that capable of being pattern filled by a color within each shape. (pp 20-22 discloses an example of pattern filling with a color of a element on the grayscale image)



As per independent claim 6, Claim 6 recites similar limitations as in claim 1 and is similar rejected under rationale. Furthermore, Coloring.com discloses one or more grayscale images. (pp 5-8,10: User able to select a number of images to choose from)

As per dependent claim 7, Coloring.com discloses system further comprising: at least one color selection tool, means for allowing a user to select at least one color with the color selection tool, and means for applying the at least one selected color as at least one color component of the content image. (pp20-22: A user selects a color on the color palette on the menu on the left. Then once the color has been selected, the user clicks on a pattern of a portion of the image to fill it with the selected color. Doing so fills the up that portion or pattern with that color shown)

As per dependent claim 8, claim 8 recites similar limitations as in claim 4 and is similarly rejected under rationale.

As per independent claim 10, Claim 10 recites similar limitations as in claim 1 and is similar rejected under rationale.

As per independent claim 11, Claim 11 recites similar limitations as in claim 3 and is similar rejected under rationale.

As per dependent claim 13, claim 13 recites similar limitations as in claim 1 and is similarly rejected under rationale.

As per independent claim 14, Claim 14 recites similar limitations as in claim 3 and is similar rejected under rationale.

As per independent claim 16, Coloring.com discloses a method comprising:

- receiving electronic product desire information, the information including at least one markup language element capable of accepting content, at least one grayscale image, and identifiers of a plurality of colors, and
- (pp 8, 9-16,17-18: Coloring.com provides the information of as least one markup language element capable of accept content. Coloring.com discloses a web site being viewed in a web browser with markup elements being shown capable of receiving colors from the palette on the left menu of colors. FIG 9-16, 18 discloses the source code behind the web page of the element showing Javascript elements used to display a graphic or image that contain many patterns and shapes used to form a figure on a different colored background. The Javascript code written in HTML enables the graphic or image to accept colors. Furthermore, Coloring.com discloses a grayscale images wherein only the two colors are shown, white and black; wherein black and white images are form of grayscale images. Thus, the grayscale image is used as content for the element shown in pp 8 of the web page. Finally, Coloring.com discloses a palette of colors that enable a user to from on the left. Therefore, Coloring.com discloses "receiving electronic product design information" as stated)
- processing the received information in the browser program to display an electronic product design to a user, the electronic design including at least one element filled with a color image generated by replacing at least one color component of the grayscale image and at least one color from the

plurality of colors. (Using Internet Explorer as shown to access Coloring.com, Coloring.com discloses a "electronic design" that includes an image or graphic that has one component replaced by one of the colors selected from the color palette. (pp 20-22)

As per dependent claim 17, Claim 17 recites similar limitations as in claim 3 and is similar rejected under rationale.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 5, 9, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Coloring.com, "Coloring.com - free online interactive coloring pages and coloring books", 11/29/2002, pp 1-25) in further in view of (Sams Publishing, "Sams Teach Yourself Microsoft Publisher 2000 in 10 Minutes", published 5/6/1999, printed pages 1-11)

As per dependent claim 2, Coloring.com discloses a method further comprising:

- displaying at least the modified content image to a user of the computer browser program (pp 22)
- modifying the content image by replacing one of the color components of the content image with at least one of the selected colors, and displaying the

newly modified content image to the user. (pp 23-25: user selects a color, clicks on the already modified portion of the content of colored filled in from pp22, wherein pp26 discloses the new color replacing the old color.)

However, Coloring.com fails to specifically disclose providing a plurality of color groups, allowing the user to select a group from the plurality of groups, and after the selection of a group by the user modifying the content image by replacing one of the color components of the content image with at least one of the selected colors in the selected group. However, Sams Publishing discloses one of Microsoft Publisher 2000 feature that provides a plurality of color schemes which the user is able to choose a scheme for coloring purposes. (pp 4) It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Coloring.com ability to color images on a web page with Sams Publishing's disclosure of Microsoft Publisher 2000 ability to choose coloring schemes since it would provided the user options of to make personalized customizable publication based on the users interests. Thus, after selecting a color scheme, a user would be able to select a color from the selected scheme to modified the content image.

As per dependent claim 5. Coloring.com discloses the ability to save the modified graphic or image by right-clicking and saving it to a user's system. (pp 26-27) However, Coloring.com fails to disclose incorporating the content image into an electronic product design, and displaying the electronic product design to the user. However, Sams Publishing discloses that Microsoft Publisher 2000, hereinafter "Publisher", has the ability to create publication pages that include flyers, postcards etc. (pp 1-7) Thus, a

user can create a flyer using the publication wizard, then use the insert picture option. (pp 8-10) Doing so, incorporates the saved modified image from the user's system into Publisher's flyer where it is displayed to the user.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Coloring.com's method of coloring grayscale images to include Sam's Publishing disclosure of Publisher that enables a user to incorporate images and graphics into a publication since Sams Publishing's disclosure of Publisher provides the benefit of using Publisher which is an easy-to-use desktop publishing tool that allows a user to create variety types of publications that include importing images or graphics to make it look professional.

As per dependent claim 9, claim 9 recites similar limitations as in claim 5 and is similarly rejected under rationale.

As per dependent claim 12, claim 12 recites similar limitations as in claim 5 and is similarly rejected under rationale.

As per independent claim 15, Claim 15 recites similar limitations as in claim 3 and is similar rejected under rationale.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. JavaBoutique, "Jake's Coloring Book", published 5/7/1999, pgs: 1-2: Discloses online coloring book on a markup language web site capable of editing images using a color palette.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Faber  
Patent Examiner  
AU 2178



**STEPHEN HONG**  
SUPERVISORY PATENT EXAMINER